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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 831,926	05 15 2001	Mikio Inoue	1182-01	2193

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SCHNADER HARRISON SEGAL & LEWIS, LLP  
1600 MARKET STREET  
SUITE 3600  
PHILADELPHIA, PA 19103

EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09 26 2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/831,926

Applicant(s)

INOUE ET AL

Examiner

Elizabeth M Cole

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 3-12 and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 and 22-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 3-7 and 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of.
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claims 8-12 and 22-31 are objected to under 37 CFR 1.75C as being in improper form because a multiple dependent claim may not depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 8-12 and 22-31 have not been further treated on the merits.

2. Claims 1-2, 13, 14 are deleted. Claim 8-12, and 22-31 are withdrawn from consideration. Therefore, an action on claims 3-7, 15-21 follows.

3. Claims 3, 5-6, 15, 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3 and 15, there is no antecedent basis for "the contact faces". In claims 5-6 and 17-18 it is not clear what is meant by "substantially consists of". Does this correspond to "consisting of" or "consisting essentially of" or "comprising"?

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-7, 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56-093265 in view of JP 8-00797.

JP 56-093265 discloses a porous sheet comprising a plurality of expanded graphite particles and a fluoro resin, (i.e., a water repellant). JP 56-093265 differs from the claimed invention because it

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does not teach incorporating inorganic fibers such as carbon fibers into the porous sheet material. JP 8-00797 discloses that incorporating short carbon fibers into a fuel cell body comprising a water repellant resin allows the fuel cell to be made thin while enhancing the strength of the material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated short carbon fibers into the fuel cell of JP 56-093265 in order to enhance the overall strength of the material. With regard to the fiber length, it would have been obvious to one of ordinary skill in the art to have selected the proper length of fiber through the process of routine experimentation in order to arrive at a product having the desired degree of fiber entanglement and overall strength. With regard to the limitation that the fibers form indentations in the expanded graphite, since the specification teaches at page 5 that expanded graphite is highly deformable and that any pressure results in the deformation of the graphite, presumably the sheet of JP 56-093265 would inherently possess this property.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (703) 308-0037. The examiner may be reached between 6:30 AM and 5:00 PM Monday through Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (703) 308-2414.

Inquiries of a general nature may be directed to the Group Receptionist whose telephone number is (703) 308-0661.

The fax number for official faxes is (703) 872-9310. The fax number for official after final faxes is (703) 872-9311. The fax number for unofficial faxes is (703) 305-5436.

Serial Number: 09 831.926

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*Elizabeth M. Cole*

Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771

e.m.c

September 23, 2002